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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WALSH, BRIAN D

ART UNIT PAPER NUMBER

3722

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/838,305

Applicant(s)

ERICKSSON ET AL.

Examiner

Brian D. Walsh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,6-9,11-20 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-27 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 22-24 is/are rejected.
- 7) ☒ Claim(s) 1-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This is a second-action, non-final in response to Applicant's Appeal Brief, filed April 12, 2004. The Examiner has determined that a more appropriate rejection should have been made to claims as detailed below.

2. In view of the arguments filed on 4/12/04, PROSECUTION IS HEREBY REOPENED.  
As set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1, 3, 6, 7 and 22 – 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA (Applicant's admission of Prior Art) in view of Carroll (U.S. Pat. No. 5,624,214).

Regarding claims 1, 22 and 23, Applicant has set forth in figures 1 – 3 and in the specification (page 5, paragraph 30 – page 7, paragraph 32) elements from claim 1 that are known in the prior art. For examples, AAPA has set forth that a cutting tool system comprising a clamping device (15A, 15B) and a clamping actuator (17A, 65B) arranged to act on the clamping block to cause the clamping block to apply tool securing clamping force to the shaft (3A, 3B) of the cutting tool are known in the prior art.

AAPA has not set forth that a spring-loaded element is known to be used in combination with the above noted elements in a cutting tool system.

Regarding claims 1, 22 and 23, Carroll discloses a cutting tool system similar to the instant invention comprising a clamping block (62, figure 6) and an aperture through the clamping block to allow a clamp actuator (61A, 61B, again figure 6) to provide a tool-securing force to the shaft (11) of a cutting tool. Carroll also discloses a spring-loaded element (32) projecting from the aperture surface and engaging a recess (72, figure 7) formed in the envelope surface when the cutting tool and its cutting edge are in the desired position by providing an increase in force necessary to displace the cutting tool from the desired position.

Regarding claim 3, Carroll discloses the shaft (11) is displaceable along a long axis of the shaft with the spring-loaded element resisting this movement.

Regarding claims 6 and 7, AAPA discloses the shaft and aperture are substantially cylindrical, Carroll discloses the recess is a dimple and can comprise a line of dimples extending in a line parallel to the axis of the shaft.

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Regarding claim 24, Carroll discloses the rotatable element (32) is a sphere.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus as disclosed by AAPA to include the spring loaded element as taught by Carroll since Carroll teaches this element in order to allow for varying the distance of a cutting edge of a cutting tool from a holder (col. 1, lines 17 – 50).

*Allowable Subject Matter*

4. Claims 25, 26 and 27 are allowed.

5. Claims 8, 9 and 11 - 20 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: the Examiner has already addressed reasons for allowable subject matter pertaining to claims 26 and 27. Please refer to the final action, filed 03 March, 2003.

Regarding claims 8 and 11, Applicant sets forth a recess in the form of a groove situated perpendicular to the long axis of the tool. The Examiner has reconsidered this element and determined that the prior art did not disclose nor render obvious this configuration nor a reasonable teaching that would inspire one of ordinary skill in the art to combine teachings to arrive at this particular configuration. Carroll does not lend itself to be modified to have a groove as opposed to a dimple recess since the polygonal cross-section of the tool already provides restriction from rotation. Figure 10 shows a quick-release mechanism with a groove, but this element is not for axial adjustment of the tool and, therefore, does not apply to the

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claimed subject matter. The Examiner determined that modification of the base reference or Carroll in order to achieve the perpendicular groove would require significant hindsight reconstruction.

Similarly, the prior art did not disclose nor render obvious a V-shaped cross-section for the recess as disclosed in claim 13. The Examiner has already relied upon Carroll to modify teachings by AAPA. Further modification to Carroll sets forth significant hindsight reconstruction. The closest reference that teaches axial adjustment involving V-shaped cross-sectional recesses in a cutting tool is that of Käsmeier et al. (U.S. Pat. No. 5,660,400). However, Käsmeier et al. doesn't show a true clamping mechanism and uses threaded fasteners to engage the recess as opposed to the spring-loaded elements taught by AAPA and Carroll.

Regarding claim 25, the closest combination of references the Examiner set forth for this examination was that of AAPA and Carroll. Carroll includes a polygonal shaft and, therefore, could not be modified to be rotatable within the clamping mechanism without destroying the workability of the device. This is further evident in that Carroll teaches a rotating, axially driven tool which specifically requires that the shaft of the tool *not be rotatable* within the clamping mechanism.

### ***Response to Arguments***

7. Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

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*Faxing of Responses to Office Actions*

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to all Office Actions directly into the Group at (703) 872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the Examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the Examiner.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Walsh whose telephone number is (703) 605-0638. The examiner can normally be reached on Monday - Friday 8:30 A.M. to 6:00 P.M., with every-other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (703) 308-2159.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



BDW  
June 10, 2004



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